

ESTTA Tracking number: **ESTTA709394**Filing date: **11/18/2015**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	City Year, Inc.
Granted to Date of previous extension	11/18/2015
Address	285 Coumbus Avenue Boston, MA 02116 UNITED STATES

Correspondence information	Cynthia Johnson Walden Principal Fish & Richardson, P.C. One Marina Park Drive Boston, MA 02210 UNITED STATES TMDocTC@fr.com
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Applicant Information

Application No	86536969	Publication date	07/21/2015
Opposition Filing Date	11/18/2015	Opposition Period Ends	11/18/2015
Applicant	Matthew Synenberg Ronen Apt 5A New York, NY 10011 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Business consultation services to assist non-profit organizations in finding, managing, and hiring potential employees; Providing temporary, full-time and contract employment placement, staffing, consulting and recruiting services and providing information on careers and temporary staffing for non-profit sector jobs

Grounds for Opposition


Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1749039	Application Date	01/28/1992
Registration Date	01/26/1993	Foreign Priority Date	NONE

Word Mark	CITY YEAR
Design Mark	
Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 1987/02/27 First Use In Commerce: 1987/12/01 organizing and conducting volunteer programs in a variety of public, community, social and youth services

U.S. Registration No.	1750618	Application Date	01/28/1992
Registration Date	02/02/1993	Foreign Priority Date	NONE

Word Mark	CITY YEAR
Design Mark	
Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 1989/09/12 First Use In Commerce: 1989/09/12 organizing and conducting volunteer programs in a variety of public, community, social and youth services

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	WHERE WILL YOU DO YOUR SERVICE YEAR		
Goods/Services	Organizing and conducting volunteer programs in a variety of public, community, social and youth services		

Related Proceedings	91222026
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Attachments	74240998#TMSN.png(bytes) Notice of Opposition.pdf(309235 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/John P. McCormick/
Name	John P. McCormick
Date	11/18/2015

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Serial No. 86/536,969
Filed on February 17, 2015
For the Mark SERVICEYEAR
Published in the Official Gazette on July 21, 2015

CITY YEAR, INC.,

Opposer,

v.

MATTHEW SYNENBERG RONEN,

Applicant.

Opposition No. _____

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

NOTICE OF OPPOSITION

City Year, Inc. ("Opposer" or "City Year"), a non-profit Massachusetts corporation having a principal place of business at 287 Columbus Avenue, Boston, Massachusetts 02116 believes that it will be damaged by the registration of the mark SERVICEYEAR that is the subject of Application Serial No. 86/536,969 (the "Application"), which was published for opposition on July 21, 2015. Applicant hereby opposes the Application, alleging as grounds for its opposition that:

1. City Year is a non-profit organization that was founded in 1987 to promote the power of a service year for young people as a means of building a stronger democracy and to provide critically needed services to students, schools and communities.

2. City Year currently has operations in 26 different cities in 18 different states throughout the United States, and it also has two international affiliate locations. Over the course of the past 28 years, City Year has built up valuable goodwill in the CITY YEAR mark with the public at large and in particular in the non-profit volunteer community.

3. City Year owns a number of federal registrations of the CITY YEAR mark including the following:

- Registration No. 1,749,039 which issued on January 26, 1993 and asserts a first use in commerce date of December 1, 1987;
- Registration No. 1,750,618 which issued on February 2, 1993 and asserts a first use in commerce date of September 12, 1989.

These registrations are valid, subsisting and incontestable. See Exhibit A

4. In addition to the CITY YEAR name and mark, another important slogan that City Year uses in connection with its organization is WHERE WILL YOU DO YOUR SERVICE YEAR. City Year began using the slogan WHERE WILL YOU DO YOUR SERVICE YEAR back in 1989 in connection with promoting its organization and conducting its volunteer programs ha a variety of public, community, social and youth services. Through the use of the slogan WHERE WILL YOU DO YOUR SERVICE YEAR for the past 26 years, City Year has built up valuable goodwill in the slogan and the volunteer community and the public at large have come to associate this slogan with City Year.

5. City Year's first use of the CITY YEAR name and mark and the WHERE WILL YOU DO YOUR SERVICE YEAR slogan are long prior to the February 17, 2015 the filing date of the Application herein opposed or any use or constructive use of mark SERVICEYEAR by Applicant.

6. Matthew Synenberg Ronen ("Applicant") seeks to register the mark SERVICEYEAR for "Business consultation services to assist non-profit organizations in finding, managing, and hiring potential employees; Providing temporary, full-time and contract employment placement, staffing, consulting and recruiting services and providing information on careers and temporary staffing for non-profit sector jobs" ("Applicant's Services") in International Class 35.

7. Applicant filed the Application on February 17, 2015 based on an intent-to-use the mark SERVICEYEAR in United States commerce under Section 1(b) of the Lanham Act.

8. The priority date of City Year's use of the slogan WHERE WILL YOU DO YOUR SERVICE YEAR long pre-dates Applicant's filing date of SERVICEYEAR in United States commerce, Applicant's filing date for the mark SERVICEYEAR and any use in commerce or other priority date that could be asserted by Applicant.

9. Applicant's mark SERVICEYEAR is confusingly similar to City Year's WHERE WILL YOU DO YOUR SERVICE YEAR slogan in appearance, sound and commercial impression, particularly when used in connection with Applicant's Services, as identified in the application, and is likely to be confused with the same.

10. Applicant seeks to register the mark SERVICEYEAR in connection with non-profit employment placement services, which is highly similar to City Year's business and services.

11. Upon information and belief, Applicant's targeted consumer base overlaps with, or will overlap with, City Year's targeted consumer base.

12. Applicant's use of the mark SERVICEYEAR is likely to cause confusion, mistake or deception in the minds of prospective purchasers as to the origin, source, sponsorship or

association of Applicant's Services with City Year, thereby causing loss, damage, and injury to City Year.

13. Registration of the mark SERVICEYEAR by Applicant would be a further source of damage to City Year because it would confer upon Applicant various statutory presumptions to which it is not entitled to City Year's detriment.

14. For the foregoing reasons, the registration sought by Applicant is contrary to the provisions of Sections 2 and 43 of the Lanham Act, 15 U.S.C. §§ 1052 and 1125, and City Year would be damaged thereby.

15. In order to protect the public against confusion and deceit, and to protect against infringement, the Application to register the mark SERVICEYEAR by Applicant should be refused under Sections 2(d) and 13 of the Lanham Act, 15 U.S.C. §§ 1052(d) and 1063.

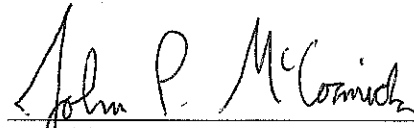
WHEREFORE, Opposer believes that it will be damaged by registration of Applicant's designation SERVICEYEAR, prays that it not be allowed, and that this opposition be sustained.

Please recognize as attorneys for Opposer in this proceeding Cynthia Johnson Walden (member of the bar in the State of Massachusetts) and the law firm of Fish & Richardson, P.C., located at One Marina Park Drive, Boston, Massachusetts 02210. Please direct all communications to the attention of Cynthia Johnson Walden, Esq., at Fish & Richardson P.C

Please charge Deposit Account 06-1050, Order No. 41309-0002PP2 for the filing fee for this Notice of Opposition, as well as for any other fees that may be due.

Respectfully submitted,

Date: November 18, 2015

A handwritten signature in black ink, appearing to read "John P. McCormick". The signature is written in a cursive, flowing style. It is positioned above a horizontal line that separates it from the printed text below.

Cynthia Johnson Walden
John P. McCormick
Fish & Richardson P.C.
One Marina Park Drive
Boston, MA 02210
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

Attorney for Opposer,
CITY YEAR, INC.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Notice of Opposition has this 18th day of November 2015, been mailed by prepaid first class mail to the below-identified Attorney at his place of business:

Kaye Scholer LLP
Paul C. Llewellyn
Partner
250 W 55th St.
New York, NY 10019

Alyssa Lubera

EXHIBIT A



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Typed Drawing

Word Mark CITY YEAR
Goods and Services IC 042. US 100 107. G & S: organizing and conducting volunteer programs in a variety of public, community, social and youth services. FIRST USE: 19870227. FIRST USE IN COMMERCE: 19871201
Mark Drawing Code (1) TYPED DRAWING
Serial Number 74241005
Filing Date January 28, 1992
Current Basis 1A
Original Filing Basis 1A
Published for Opposition November 3, 1992
Registration Number 1749039
Registration Date January 26, 1993
Owner (REGISTRANT) City Year, Inc. NON-PROFIT CORPORATION MASSACHUSETTS 285 Columbus Avenue Boston MASSACHUSETTS 02116
Assignment Recorded ASSIGNMENT RECORDED
Attorney of Record Michael J. Bevilacqua, Esq.
Type of Mark SERVICE MARK
Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20130214.

11/18/2015

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Renewal 2ND RENEWAL 20130214

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Word Mark CITY YEAR
Goods and Services IC 042. US 100 101. G & S: organizing and conducting volunteer programs in a variety of public, community, social and youth services. FIRST USE: 19890912. FIRST USE IN COMMERCE: 19890912
Mark Drawing Code (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code 26.01.07 - Circles with a decorative border, including scalloped, ruffled and zig-zag edges
 26.01.18 - Circles, three or more concentric; Concentric circles, three or more; Three or more concentric circles
 26.01.21 - Circles that are totally or partially shaded.
 26.05.02 - Plain single line triangles; Triangles, plain single line
 26.05.13 - Triangles, exactly two triangles; Two triangles
Serial Number 74240998
Filing Date January 28, 1992
Current Basis 1A
Original Filing Basis 1A
Published for Opposition November 10, 1992
Registration Number 1750618

Registration Date February 2, 1993

Owner (REGISTRANT) City Year, Inc. NON-PROFIT CORPORATION MASSACHUSETTS 285 Columbus Avenue Boston MASSACHUSETTS 02116

Assignment Recorded ASSIGNMENT RECORDED

Attorney of Record Michael J. Bevilacqua, Esq.

Type of Mark SERVICE MARK

Register PRINCIPAL

Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20130220.

Renewal 2ND RENEWAL 20130220

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